

Application No.: 09/457,926  
Attorney Docket No.: 9210.0004-00

### REMARKS

#### **I. Disposition of the Claims**

Claims 41-46, 49-51, 53-55, 57, and 58 are currently pending in the application.

As discussed below, claim 41 was amended to replace the variable "P" in formula (b) with the variable "M," as well as amending the text of the claim in a corresponding manner. Additionally, the specification was amended in five instances to make a similar replacement. Applicants submit that no new matter was introduced by these amendments, which are merely clerical in nature.

#### **II. Interview**

Applicants wish to thank Examiner Mark Shibuya and Supervisory Patent Examiner Andrew Wang for granting Applicants' representative, Mark Sweet, the courtesy of a personal interview conducted on May 18, 2004. During this interview, Applicants' representative and the Examiners discussed the Applicants' use of variable "P" in figure (b) in claim 41. The Examiner's pointed out that the use of the variable "P" could cause confusion since the chemical symbol "P" represents phosphorus. Accordingly, Applicants' representative agreed to amend claim 41, as well as all similar occurrences in the specification, to replace the variable "P" with another variable that does not represent a chemical element. The foregoing amendments replacing "P" with "M" obviate any confusion that may have been previously caused.

Applicants' representative and the Examiners additionally discussed the rejection under 35 U.S.C. § 112, first paragraph. In particular, the Applicants' representative and the Examiners discussed the requirements of 35 U.S.C. § 112, first paragraph, Applicants' previous Response addressing the *Wands* factors, and the guidance provided by the instant specification. U.S. Pat. No. 5,693,791 to Truett ("Truett"), which

Application No.: 09/457,926  
Attorney Docket No.: 9210.0004-00

was previously relied upon by the Examiner in a rejection under 35 U.S.C. § 103(a) that has since been withdrawn, was also discussed as generally teaching that antibiotic moieties linked together can exhibit antibiotic properties.

**III. Rejection Under 35 U.S.C. § 112**

The Examiner rejected claims 41-46, 49-51, 53-55, 57, and 58 under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in a way as to enable one of ordinary skill in the art to use the invention. Office Action, p. 3. On April 12, 2004, Applicants filed a complete response under 37 C.F.R. § 1.111, which responded to the Examiner's grounds for rejection. This previous Response is incorporated by reference in its entirety.

As requested by the Examiners, Applicants submit the following additional reason in support of their position that the pending claims meet the requirements of 35 U.S.C. § 112, first paragraph. In the rejection, the Examiner stated that "it would not be predictable that the claimed compounds would have any biological activity." Office Action, p. 5. As discussed during the interview, Applicants submit that, at the time the Applicants filed their specification, it was understood in the art that two antibiotic moieties linked together can exhibit antibiotic properties.

For example, Truett discloses "a wide variety of antibiotics of new and novel structure and antimicrobial activity." Truett at col. 1, lines 5-7. Truett, which does not teach or suggest the compounds recited in Applicants' pending claims, contains the general teaching that "the linking of two antibiotic moieties functioning in different fashions . . . can be of value [as antibiotics]." Truett at col. 1, lines 24-27. Truett further teaches that the linking of two antibiotic moieties via a linking group can produce structures "with a wide range of antibiotic activity." *Id.* at col. 1, lines 45-50. In other

Application No.: 09/457,926  
Attorney Docket No.: 9210.0004-00

words, one of ordinary skill in the art would understand Truett as a general teaching that two antibiotic moieties linked together can have antibacterial activity. *Id.* at col. 1, lines 1-30.

Applicants respectfully submit that Truett provides evidence that it was known compounds comprising two antibiotic moieties linked together by a linking group can have antibacterial activity. This evidence also provides support of Applicants' position that their claimed compounds, which comprise two moieties linked through a linking group, as defined in claim 41, could exhibit antibiotic activity. Accordingly, for the reasons provided above as well as Applicants' response filed April 12, 2004, under 37 C.F.R. § 1.111, Applicants respectfully request withdrawal of the § 112, first paragraph rejection.

#### IV. Conclusion

Applicants respectfully request reconsideration of the application, and the timely allowance of all pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 15, 2004

By:



Mark D. Sweet  
Reg. No. 41,469